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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,265	08/23/2001	Bart C. Thielges	LANDP00001	1181
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ROBERT C. ROLNIK The Rolnik Law Firm, P.C. 24 N. Main St. KINGWOOD, TX 77339			EXAMINER LOFTIS, JOHNNA RONEE	
			ART UNIT 3624	PAPER NUMBER
			NOTIFICATION DATE 03/04/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

notices@rolnikiplaw.com

Office Action Summary**Application No.**

09/938,265

Applicant(s)

THIELGES ET AL.

Examiner

JOHNNA R. LOFTIS

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final office action upon examination of application number 09938265. Claims 42-48 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments with respect to claims 42-48 have been considered but are moot in view of the new ground(s) of rejection. Examiner acknowledges Applicant's previous assertion that their invention dates prior to March 16, 2000.
3. Examiner has re-issued rejections under 35 USC 101.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 42-48 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being

transformed, for example by identifying the material that is being changed to a different state. (See Memorandum from John J. Love, Deputy Commissioner for Patent Examination Policy, dated January 7, 2009)

Here, Applicant's method steps recite a mere field of use and is generally insufficient to render an otherwise ineligible method claim patent eligible. The apparatus must impose meaningful limits on the method claim's scope to pass the test. Thus, claims 42-48 are non-statutory.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al, US 6990458.

As per claim 42, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication), the service request being transmitted to the system (column 4, lines 9-27 – service request is entered into the service request input terminal); identifying with the system an appropriate technician to respond to the request by successively reviewing increasingly more general; and relaying at least part of the service request (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service

requests to available technicians; column 7, lines 1-45 – successive review of technicians to determine a qualified technician for the work order). While Harrison et al does not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

As per claim 43, Harrison et al teaches identifying the appropriate associate to fulfill the request but does not each the identifying step is a hierarchical tree traversal search through successive hierarchical levels towards the root of the hierarchical tree. However, the search utilized in Harrison et al is functionally equivalent to a hierarchical tree traversal since the two processes achieve the same goal and reach the same result, i.e., the identification of the appropriate person to fulfill a request. Since the two are functionally equivalent, it would have been obvious to one of ordinary skill to employ a database query tool such as this in order to identify the appropriate person to fill the request.

As per claim 44, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same

regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

As per claim 45, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication), the service request being transmitted to the system (column 4, lines 9-27 – service request is entered into the service request input terminal); identifying, with the system, a technician by successively reviewing increasingly more general descriptions until an appropriate technician is identified; and relaying at least part of the service request from the service requestor (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service requests to available technicians; column 7, lines 1-45 – successive review of technicians to determine a qualified technician for the work order). While Harrison et al does not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

As per claim 46, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

As per claim 47, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication), the service request being transmitted to the system (column 4, lines 9-27 – service request is entered into the service request input terminal); identifying, with the system, a technician by successively reviewing increasingly more general descriptions until an appropriate technician is identified; and relaying at least part of the service request from the service requestor to the technician identified (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service requests to available technicians; column 7, lines 1-45 – successive review of technicians to determine a qualified technician for the work order). While Harrison et al does not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

As per claim 48, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Johnna R Loftis/
Examiner, Art Unit 3624